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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,135	02/13/2004	Shingo Masuko	025720-00023	3797

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EXAMINER

NGUYEN, DONGHAI D

ART UNIT	PAPER NUMBER
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3729

DATE MAILED: 06/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/777,135	Applicant(s) MASUKO, SHINGO	
	Examiner Donghai D. Nguyen	Art Unit 3729	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 14-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed on April 21, 2006 has been considered and made of record.

Election/Restrictions

2. Applicant's election with traverse of Group I in the reply filed on April 21, 2006 is acknowledged. The traversal is on the ground(s) that independent claims 1 and 14 recite a common patentable feature. This is not found persuasive because of the reasons provided in the previous Office Action dated 1/24/06, paragraphs 1-4. Further, the invention of claim 14 can be made by another and materially different process other than the process recited in claim 1, such as forming a storage tray having plurality cavities for holding electronic components.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4 6-10 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 6,268,236 to Miyawaki.

Regarding claim 1, Miyawaki discloses a method of fabricating electronic parts comprising the steps of: mounting electronic elements (7) in regular cavities (4) that are two-

dimensionally arranged on a baseboard (1, see Fig. 5) on which dummy cavities (5, 10A-B) are provided so as to located further out than the array of the regular cavities and surround the array of regular cavities (Note: the Examiner broadly considers only the cavities at the perimeter of each regions/quadrants as shown in Fig. 5), no electronic elements being mounted in the dummy cavities (see Fig. 6); and covering a top of the baseboard with a resin sheet (sheet-like adhesive 3 see Col. 3, lines 61-63 make of resin see Col. 5, lines 46-48).

Regarding claim 2, Miyawaki discloses supplying resin of the resin sheet to given dummy cavities (holes 5, trenches 10A-B) having bottoms that are not metallized (see Figs. 5 and 6).

Regarding claim 3, Fig. 6 of Miyawaki shows the regular and dummy cavities can be hermetically sealed.

Regarding claim 4, Miyawaki discloses diving the baseboard into separate electronic parts each of which includes one of the electronic elements in a corresponding one of the regular cavities (See Fig 2C).

Regarding claims 6-10, Miyawaki discloses the configuration and location of the dummy cavities (holes 5, trenches 10A-B) on the baseboard (see Figs. 3-6).

Regarding claim 12, Miyawaki discloses attaching a wiring board to a backside of the baseboard so that terminals on the wiring boards are electrically connected to terminals (11) in the regular cavities by via interconnections provided in the baseboard (See Col. 3, lines 30-33).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyawaki in view of Applicant Admitted Prior Art (AAPA).

Miyawaki does not disclose the dummy cavities are at least 50 μm deep and the electronic elements are surface acoustic wave filter chips. AAPA teaches the above limitations (Fig. 2) for forming SAW devices (See Applicant's spec. page 2, lines 9-12). It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the teaching of AAPA including the dummy cavities are at least 50 μm deep and the electronic elements are surface acoustic wave filter chips into Miyawaki's invention to obtain SAW devices.

Response to Arguments

7. Applicant's arguments filed on April 21, 2006 have been fully considered but they are not persuasive. Applicant argues that Miyawaki does not anticipate the invention of claim 1 (see "Remarks" page 10, 2nd paragraph). The Examiner disagrees because the Miyawaki is still a valid reference because it teaches every aspect method invention steps alone with number of structural elements (see paragraph 3 above) which associated with the process such as dummy

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cavities 5's where no electronic element being mounted therein. Note: reference 5's of the reference read on the claimed dummy cavities of the present invention.

This application contains claims 14-24 drawn to an invention nonelected with traverse the amendment filed on April 21, 2005. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Allowable Subject Matter

8. Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donghai D. Nguyen whose telephone number is (571)-272-4566. The examiner can normally be reached on Monday-Friday (9:00-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter D. Vo can be reached on (571)-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DN

June 14, 2006


MINH TRINH
PRIMARY EXAMINER